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Brief
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Reissue Application of: Willibald KRAUS

Serial No.: 08/230,083

Group Art Unit: 3749

Filed: April 20, 1994

Examiner: H. Joyce

For: CHECK VALVE ASSEMBLY

Attorney Docket No.: TRWZ 2 00136-4

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REPLY BRIEF

Under 37 C.F.R. § 1.193(b)(1)

This Reply Brief is responsive to the Supplemental Examiner's Answer mailed from the U.S. Patent and Trademark Office on November 8, 2004 in connection with the above-identified matter.

I. REAL PARTY IN INTEREST

The assignee of this application, TRW United-Carr GmbH and Co., KG is now TRW Automotive Electronics & Components GmbH and Co., KG. TRW Automotive Electronics & Components GmbH and Co., KG is the real party in interest.

II. RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences.

III. STATUS OF CLAIMS

Reissue Application Claim 1	Pending	(Allowed)
Reissue Application Claim 2	Pending	(Allowed)
Reissue Application Claim 3	Pending	(Allowed)
Reissue Application Claim 4	Pending	(Allowed)
Reissue Application Claim 5	Pending	(Allowed)
Reissue Application Claim 6	Pending	(Allowed)
Reissue Application Claim 7	Pending	(Allowed)
Reissue Application Claim 8	Pending	(Allowed)
Reissue Application Claim 9	Pending	(Allowed)
Reissue Application Claim 10	Pending	(Allowed)
Reissue Application Claim 11	Pending	(Allowed)
Reissue Application Claim 12	Pending	(Allowed)
Reissue Application Claim 13	Pending	(Allowed)
Reissue Application Claim 14	Pending	(Rejected <u>only</u> under "Recapture Rule")
Reissue Application Claim 15	Canceled	
Reissue Application Claim 16	Pending	(Rejected <u>only</u> under "Recapture Rule")

The original application as filed on January 17, 1991 had fourteen (14) claims. Claims 2, 6, and 12-14 contained allowable subject matter as filed. More particularly, claims 2, 6, and 12-14 were indicated as being allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 2 and 12 were canceled by way of an amendment filed on September 10, 1991. Claims 15 and 16 were added by way of the amendment filed on September 10, 1991. Claim 15 was, essentially, claim 2 rewritten into

independent form to include the limitations of base claim 1. Claim 16 was, essentially, claim 12 rewritten into independent form to include the limitations of base claim 1 and intervening claims 10 and 11. Original claim 1 was canceled by way of an Examiner's Amendment on November 8, 1991. The original application issued as U.S. Patent No. 5,105,731 on April 21, 1992. Pending claims 3-11 and 13-16 were renumbered as claims 1-13 in U.S. Patent No. 5,105,731.

The instant reissue application was filed on April 20, 1994. The reissue application maintained claims 1-13 from the '731 patent and added new claims 14-16. Claim 15 was canceled by way of an amendment filed on August 15, 1995 in the reissue application. Claims 1-14 and 16 were allowed in a Notice of Allowability mailed on November 6, 1996.

In a Letter from the Office of Patent Publication mailed March 11, 1998, the reissue application with allowed claims 1-14 and 16 was indicated as being withdrawn for consideration of Quality Review's determination that the claims are not subject to reissue since recapture exists. The Notice indicated that the withdrawal was requested by the Group Director.

In an Office Action subsequent to the Notice mailed on April 9, 1998 the Examiner indicated that the scope of claim 14 differs from that of originally filed claim 1 in the original application and does not appear to be broader in any aspect than original claim 1. According to the Examiner in the Notice of April 9, 1998, claim 14 in the reissue application does not violate the recapture rule. Claim 16 was rejected under the equitable "Recapture" Doctrine.

In a subsequent Office Action mailed October 2, 1998 the Examiner reversed his position with regard to the indicated allowability of claim 14. According to the above, therefore, claims 1-14 and 16 are pending in the instant reissue application. Reissue application claims 1-13 are pending and stand allowed. Reissue application claims 14 and 16 are pending and stand rejected only under the equitable "Recapture" Doctrine. Reissue application claim 15 is canceled.

IV. STATUS OF AMENDMENTS

A statement of the status of any amendment(s) filed subsequent to final rejection is as follows below.

Applicant has located and identified the most recent Final Rejection in the instant Reissue Application. In Paper Number 30 mailed from the U.S. Patent and Trademark Office on November 9, 1999, the Examiner identified the Action as "Final".

Subsequent to Paper Number 30, applicant filed a Notice of Appeal on May 8, 2000 together with a Request for Extension of Time. No claim amendments were tendered in either the Notice of Appeal or in the Request for Extension of Time.

Applicant's representative conducted a telephonic interview with Special Program Examiner Sholl on June 7, 2000. An Interview Summary Record memorializing the telephonic interview was mailed from the Patent Office on June 9, 2000 and identified as Paper Number 33. No claim amendments were made during the telephonic interview.

Applicant filed an Appeal Brief on July 10, 2000. There were no claim amendments contained in the Appeal Brief. Accordingly, there were no claim amendments after the Final Rejection.

V. SUMMARY OF INVENTION

The invention is directed to a check valve assembly. The invention has application in connection with ventilation systems for passenger spaces in motor vehicles. In the art, the present is known as a pressure relief valve (PRV). The overall construction of the subject device is described on pages 1-6 of the specification and shown in FIGURES 1-8.

One particular embodiment of the invention (CLAIM 14) is shown in detail in Figures 6, 7, and 8 of the application and described at page 6, line 34 to page 8, line 10. With reference to those figures and with additional reference to Figures 1-5, the present check valve assembly (1, Figs. 1 and 2) is

adapted for use with a ventilation system (2, Fig. 1) for a passenger space of a motor vehicle. The assembly includes an outer housing (3, Fig. 1) having an open end and a surrounding wall (14, Figs. 1 and 6). An inner frame (4, Figs. 1-6) is received in the open end of the outer housing. A check valve element (5, Figs. 1 and 5) formed of a flexible sheet of material is clamped between the outer housing and the inner frame. In addition, first and second resilient clip connections (6, Fig. 1) joins the outer housing, the inner frame, and the check valve element to a support (2, Fig. 1) of a motor vehicle. The first clip connection includes a first spring tongue (6, Figs. 6-8) spaced from the surrounding wall. The second clip connection includes a second springy tongue (6, Fig. 1) integral with the surrounding wall.

In another embodiment shown in Figures 9-11 and described at page 8, line 11 to page 9, line 6, a check valve assembly (1, Figs. 1 and 2) includes an outer housing (3, Fig. 1) having an open end. An inner frame (4, Figs. 1-6) is received in the open end. A check valve element (5, Figs. 1 and 5) formed of a flexible sheet of material is clamped between the outer housing and the inner frame. A resilient clip connection (22', Figs. 9-11) is provided and formed separate from the outer housing (3, Fig. 1) and carried on a locking element (30, Figs. 9-11) which is connected with the outer housing, the clip connection securing the outer housing to the locking element and joining the inner frame, the outer housing, and the check valve element to the motor vehicle.

VI. ISSUES

A concise statement of the issues presented for review is as follows below.

- 1) whether independent claim 14 newly added in the instant reissue application violates the Recapture Rule; and,
- 2) whether independent claim 16 newly added in the instant reissue application violates the Recapture Rule.

VII. GROUPING OF CLAIMS

Applicant contests the ground of rejection which applies to a group of two or more claims including claims 14 and 16.

Applicant submits that the claims of the group, i.e. claims 14 and 16 do not stand or fall together.

Applicant respectfully submits that the claims of the group of rejected claims are separately patentable because claim 14 is directed to the clip connection embodiment shown in Figures 6, 7, and 8 of the specification and claim 16 is directed to the clip connection embodiment shown in Figures 9, 10, and 11.

VIII. ARGUMENT AND RESPONSE

As noted above, this Reply Brief is filed in response to the Supplemental Examiner's Answer mailed from the U.S. Patent and Trademark Office on November 8, 2004 and also to the Remand to the Examiner issued from the Board of Patent Appeals and Interferences (the "Board") on July 31, 2003.

The instant application was previously remanded to the Examiner for a determination of whether the previous rejection under 35 U.S.C. § 251 of claims 14 and 16 remains appropriate in view of a precedential opinion concerning reissue recapture, namely Ex parte Eggert, 67 U.S.P.Q.2d 1716 (Bd. Pat. App. & Interf., decided May 29, 2003) (precedential opinion of an expanded panel of the Board). As noted by the Board, in Eggert, the majority opinion applied the fact-specific analysis set forth in In re Clement, 131 F.3d 1464, 1468-71, 45 USPQ2d 1161, 1164-66 (Fed. Cir. 1997), determined that under the facts and circumstances before it, the "surrendered subject matter" was claim 1 of Eggert as that claim existed prior to the post-final rejection amendment that lead to the allowance of claim 1 in the original patent, and decided that reissue claims 15-20 of Eggert were not precluded (i.e., barred) by the "recapture rule." Slip opinion at 39-45."

The first Supplemental Examiner's Answer of July 23, 2004, however, contained a single statement that "[t]he decision in Ex parte Eggert, Appeal No. 2001-0790 (Bd. Pat. App. & Inter., decided May 29, 2003) (precedential opinion of an expanded panel of the Board) is not applicable to the facts of this Appeal."

The Second Supplemental Examiner's Answer of November 8, 2004 contained an allegation that a new issue was raised, apparently by applicant's Reply Brief. The Second Supplemental Examiner's Answer again, however, failed to apply the Eggert Analysis to the rejected claims. In fact, applicant respectfully submits that the Examiner has misinterpreted the Eggert Analysis entirely and the no new issues were raised.

Thus, the Examiner has appeared to have sustained the rejections of reissue claims 14 and 16 under the "recapture" doctrine.

Brief Answer

In view of Ex parte Eggert, and other precedents, the rejection of claims 14 and 16 under 35 U.S.C. § 251 is inappropriate. The analysis used in Eggert is consistent with appellant's position set out on page 6 of the Appeal Brief of July 10, 2000 that "the only subject matter that could be considered to have been "surrendered" by applicant in the original prosecution could only have been the scope of independent claim 1 as originally filed." A withdrawal of that rejection, therefore, is respectfully requested.

The Examiner's First Position:

The Examiner's first position in the case at hand is set out on page 6 of the Supplemental Examiner's Answer of July 23, 2004:

[I]n the instant case, the surrendered subject matter as viewed from applicant's Reply Brief Tables I and II, is any claim not having either the (sic.) limitation represented by the last six lines of patent claim 1 or the limitation represented by the last four lines of patent claim 11.

The Examiner's Second Position:

The Examiner's second position in the case at hand is set out on page 2 of the Supplemental Examiner's Answer of November 8, 2004:

[t]he limitation, "the inner frame, the outer housing and the check valve is joined to a support of the motor vehicle through a resilient clip connection", found in patent claim 11 inherently provides the securement limitation of the claimed elements as recited in claim 16 since patent claim 11 also recites that clip connection is on a locking element. (emphasis in original)

The Appellant's Position:

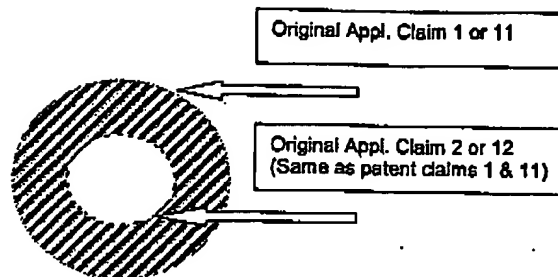
The table below should help clarify the claim relationship for the Examiner.

Original Application Claim	Patent Claim	Reissue Claim
15 (1/2)	1	14
16 (1/10/11/12)	11	16

First, applicant respectfully submits that the comments presented by the Examiner in the Supplemental Examiner's Answer of November 8, 2004 contradict the Eggert Analysis with regard to recapture. More particularly, the Examiner compares patent claim 11 with reissue claim 16 rather than original application claim 12 as directed under the Eggert Analysis.

In the instant application, using the analysis set out in Eggert applying the fact-specific analysis of In re Clement, the surrendered subject matter as viewed from Appellant's Reply Brief, Tables I and II, is the subject matter of original application claims 1 and 11. Original application claims 1 and 11 thus define the "outer circle" of the Eggert-type drawing below for each of reissue claims 15 and 16, respectively. Patent claims 1 and 11 are the (allowable) original application claims 2 and 12, respectively, rewritten into independent form and thus define the "inner circle" of the Eggert-type drawing. Reissue claims 14 and 16 lie in the shaded area and are thus allowable

because they do not attempt to "capture" subject matter lying beyond the outer circle.



Detailed Answer

The Parent Application:

The original application as filed on January 17, 1991 had fourteen (14) claims. Claims 2, 6, and 12-14 contained allowable subject matter as filed. More particularly, claims 2, 6, and 12-14 were indicated as being allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 2 and 12 were canceled by way of an amendment filed on September 10, 1991. Claims 15 and 16 were added by way of the amendment filed on September 10, 1991. Claim 15 was, essentially, allowable claim 2 rewritten into independent form to include the limitations of base claim 1. Claim 16 was, essentially, allowable claim 12 rewritten into independent form to include the limitations of base claim 1 and intervening claims 10 and 11. Original claim 1 was canceled by way of an Examiner's Amendment on November 8, 1991. The original application issued as U.S. Patent No. 5,105,731 on April 21, 1992. Original pending claims 3-11 and 13-16 were renumbered as claims 1-13 in U.S. Patent No. 5,105,731.

The instant reissue application was filed on April 20, 1994. The reissue application maintained claims 1-13 from the '731 patent and added new

claims 14-16. Claim 15 was canceled by way of an amendment filed on August 15, 1995 in the reissue application.

Reissue Claim 14 is Allowable

Eggert Analysis:

According to MPEP §1412.02, the Patent Office is following the decision laid down in In re Clement 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997) for guidance in determining whether reissue claims violate the recapture doctrine. In Eggert, the majority opinion applied the fact-specific analysis set forth in Clement and determined that under the facts and circumstances before it, the "surrendered subject matter" was claim 1 as that claim existed prior to the post-final rejection amendment that lead to the allowance of claim 1 in the original patent, and decided that reissue claims 15-20 of Eggert were not precluded (i.e., barred) by the "recapture rule."

Appellant will apply the analysis set forth in Clement to the pending claims in the instant application in the manner followed by the Board in Eggert. The guidelines are as follows:

The first step in applying the recapture rule is to compare the reissue claims with the patent claims to determine whether and in what "aspect" the reissue claims are broader than the patent claims. (Eggert, p. 1730).

If, after having determined that the reissue claims have been broadened relative to the patent claims, the next step is to determine whether those broadenings relate to surrendered subject matter. (Eggert, p 1731).

The next stage in the inquiry is to compare the rejected reissue claims to the surrendered subject matter to determine in what aspects the reissue claims are broader than the surrendered subject matter and in what aspects the reissue claims are narrower than the surrendered subject matter. (Eggert, p 1731).

Next, using the results of the above, the Clement test (as modified by Eggert) is used:

1. If the reissue claim is as broad as or broader than the canceled or amended claim [the surrendered subject matter] in all aspects, the recapture rule bars the claim;
2. If it is narrower [than the surrendered subject matter] in all aspects, the recapture rule does not apply, but other rejections are possible;
3. If the reissue claim is broader [than the surrendered subject matter] in some aspects, but narrower [than the surrendered subject matter] in others, then;
 - (a) if the reissue claim is as broad as or broader in an aspect germane to a prior art rejection, but narrower in another aspect completely unrelated to the rejection, the recapture rule bars the claim; and,
 - (b) if the reissue claim is narrower in an aspect germane to prior art rejection, and broader in an aspect unrelated to the rejection, the recapture rule does not bar the claim, but other rejections are possible. (Eggert, p 1732).

In order to best help facilitate an analysis of claim 14 using the above guidelines, appellant has prepared Table I below illustrating the differences between original application claim 1, patent claim 1, and reissue claim 14. As can be seen below in the Table, reissue claim 14 is broader than patent claim 1 in the "aspect" that the reissue claim 14 does not include the limitation of "wherein the inner frame (4) has a surrounding rim (7) carrying rib members (8) spaced transversely with stays (9) extending therefrom and a surrounding frame (10) joining the stays (9)". Also, reissue claim 14 does not include the limitation that the resilient clip connection is "carried on the outer housing."

Having determined that the reissue claim 14 has been broadened relative to patent claim 1, the next step is to "determine whether those broadenings" relate to surrendered subject matter." Also, in order to determine whether an applicant surrendered particular subject matter, one must turn to the prosecution history for arguments and changes to the claims made in an effort to overcome a prior art rejection.

To the above end, applicant respectfully notes that during prosecution, original application claims 2, 6, and 12-14 contained allowable subject matter as filed. In an amendment, without argument regarding the merits of the art of record, claim 1 was canceled and original application claim 2 was rewritten into independent form as new claim 15 to include all of the limitations of claim 2 and base claim 1 as filed. Accordingly, the only subject matter that could be considered to have been "surrendered" by applicant in the original prosecution could only have been the scope of independent claim 1 as originally filed. Original application claim 1 is repeated below in Table I.

Appellant respectfully points out that the above analysis is wholly consistent with the Eggert application of the Clement test. In Eggert, after a review of the prosecution history, it was determined that appellants added the language "said retaining member being generally bowl-shaped and convex toward said magnet" to claim 1 in response to a final rejection in order to overcome the prior art rejection based on the Parsons patent in view of the Clark and Miller patents. The Board in Eggert concluded that appellants, in adding that limitation, conceded that claim 1 prior to the amendment was not patentable, thereby surrendering the subject matter of that claim. The Board determined that the deliberate amendment of claim 1 in an effort to overcome the prior art rejection was an admission that the scope of the claim before the amendment was unpatentable and establishes that subject matter as surrendered subject matter. Therefore, in the case at hand, the surrendered subject matter is claim 1 of the original application (the "outer circle" of the Eggert drawing).

As noted above, the second step in determining whether the recapture rule is applicable is to ascertain whether the broader aspects of the

reissue claims relate to the surrendered subject matter [original application claim 1]. With regard to the rejected reissue claims at hand, appellant respectfully submits that the first broader aspect of the reissue claim 14, is the absence of the limitation of "wherein the inner frame 4 has a surrounding rim 7 carrying rib members 8 spaced transversely with stays 9 extending therefrom and a surrounding frame 10 joining the stays 9". As shown above, "surrendered" subject matter is the scope of canceled original patent claim 1 set out above. Since original application claim 1 did not include the rim, rib member and stay limitations, these broader aspects of reissue claim 14 are germane to the prior art rejection in the original application. Next, with regard to the second broader aspect of reissue claim 14, namely the absence of the limitation of the resilient clip connection being "carried on the outer housing", it is respectfully submitted that the omission of that limitation in the reissue claim is not an aspect germane to the prior art rejection during prosecution. Applicant never argued this limitation during prosecution and the Examiner did not require it in the allowable subject matter.

The next stage in the inquiry is to compare the rejected reissue claims to the surrendered subject matter to determine in what aspects the reissue claims are broader than the surrendered subject matter [original application claim 1] and in what aspects the reissue claims are narrower than the surrendered subject matter [original application claim 1]. The reissue claim 14 is broader than the surrendered subject matter in that the limitation of the resilient clip connection being "carried on the outer housing" has been omitted. However, this omitted limitation clearly relates to features which were not argued by appellants as distinguishing over the applied prior art during prosecution of the original patent application. Thus, it is respectfully submitted that this limitation is not germane to any prior art rejections contained in the original prosecution.

Next, it must be determined if the reissue claims are narrower than the surrendered subject matter [original application claim 1]. (Eggert, p 1731). Here, reissue claim 14 has been narrowed relative to both the surrendered subject matter [original application claim 1] and the patent claim 1

in that reissue claim 14 limits the first clip connection as comprising "a first springy tongue spaced from the surrounding wall, and the second clip connection comprising a second springy tongue integral with the surrounding wall." Reissue claim 14 has only been broadened relative to the surrendered subject matter [original application claim 1] in that the limitation of the resilient clip connection being "carried on the outer housing" is absent. However, this limitation is not germane in any way to the prior art rejection of original application claim 1. Alternatively, appellant respectfully submits that the limitation of the resilient clip connection being "carried on the outer housing" is inherent in the language of reissue claim 14.

Appellant respectfully refers the Board to Table I below which compares the reissue claim 14 with canceled original application claim 1. As can be seen from the Table, reissue claim 14 has the same scope as the surrendered subject matter in an aspect germane to the prior art rejection (i.e., "wherein the inner frame (4) has a surrounding rim (7) carrying rib members (8) spaced transversely with stays (9) extending therefrom and surrounding frame (10) joining the stays (9)). More particularly, neither the surrendered subject matter (original claims) nor reissue claim 14 include this limitation. Thus, the surrendered subject matter has not been expanded by the scope of reissue claim 14. Further, reissue claim 14 is broader only in aspects unrelated to the rejection (i.e., the resilient clip connection being "carried on the outer housing"). Again, however, appellant respectfully submits that the limitation of the resilient clip connection being "carried on the outer housing" is inherent in the language of reissue claim 14.

Therefore, it is respectfully submitted that in the case at hand, based upon the above, reissue claim 14 falls into the either category (2) or category (3)(b) as described by Clement.

The majority in Egert suggests that the narrowing of the reissue claim does not have to be in the same aspect of the invention, as long as the narrowing overcomes the rejection of the canceled claim. In that regard, applicant has attached hereto a copy of a Notice of Allowability at Exhibit 3 which shows that the Examiner allowed claims 1-14 and 16 in this reissue

application on the merits against the prior art background. Accordingly, it is respectfully submitted that reissue claim 14 overcomes the rejection of the canceled claim (claim 1) and falls entirely within the outer circle in the Eggert Analysis defined by originally filed claim 1.

It is respectfully submitted that reissue claim 14 falls entirely within the outer circle in the Eggert Analysis. Original application claim 1 recites a check valve assembly in association with the ventilation system for the passenger space of a motor vehicle, the assembly comprising an outer housing, an inner frame, a check valve element, and a resilient clip connection. In reissue claim 14, a check valve assembly is recited adaptable for use with a ventilation system for a passenger space of a motor vehicle, the assembly comprising an outer housing, an inner frame, a check valve element, and a resilient clip connection. In original application claim 1, the outer housing is connected with the inner frame. In reissue claim 14, the outer housing has an open end and a surrounding wall and the inner frame is received within the open end. First and second resilient clip connections join the outer housing with the inner frame. In original application claim 1, the check valve element is formed of a flexible sheet material clamped between the outer housing and the inner frame. In reissue claim 14, the check valve element is formed of a flexible sheet material and is clamped between the outer housing and the inner frame. In original application claim 1, the inner frame is received into the open end of the outer housing. Reissue claim 14 places the inner frame received in the open end of the outer housing. Original application claim 1 recites the inner frame, the outer housing, and the check valve being joined to a support of the motor vehicle through a resilient clip connection carried on the outer housing. Reissue claim 14 recites a first and second resilient clip connection joining the outer housing, the inner frame, and the check valve element to a support of the motor vehicle.

As is apparent from the above, reissue claim 14 falls entirely within the "outer circle" in the Eggert Analysis, the outer circle being defined by original application claim 1.

In addition to the above, reissue claim 14 adds the further limitation of the first clip connection comprising a first springy tongue spaced from the surrounding wall, and the second clip connection comprising a second springy tongue integral with the surrounding wall.

Again, as is apparent from the above, reissue claim 14 includes limitations beyond those presented in original application claim 1 and, therefore, falls entirely within the outer circle in the Eggert Analysis. Reissue claim 14 is narrower than the scope of the rejected claim (claim 1).

Therefore, for at least the above reasons, applicant respectfully submits that reissue claim 14 is allowable and does not violate the Recapture Doctrine according to the Eggert analysis.

Reissue Claim 16 is Allowable

Eggert Analysis:

Appellant has prepared Table II below illustrating the differences between patent claim 11 and reissue claim 16. As can be seen below in the Table, reissue claim 16 is broader than patent claim 11 in the "aspect" that the reissue claim 16 does not include the limitation of "said locking element (30) being guided over a dovetail guide (31) on the outer surface of the outer housing (3)".

However, this is irrelevant as reissue claim 16 is narrower than the surrendered subject matter (original application claims 1/10/11) in the aspect that claim 16 includes the limitation of "the slip connection securing the outer housing to the locking element and joining the inner frame, the outer housing, and the check valve element to the motor vehicle."

To the above end, appellant respectfully notes that during prosecution, original application claims 2, 6, and 12-14 contained allowable subject matter as filed. In an amendment, without argument regarding the merits of the art of record, claims 1 and 12 were canceled and original application claim 12 was rewritten into independent form as new claim 16 to include all of the limitations of base claim 1 and Intervening claims 10 and 11 as filed. Accordingly, using the analysis set out in Eggert, the only subject matter that could have been "surrendered" by applicant in the original prosecution could only have been the scope of independent claim 1 as originally filed combined with dependent claims 10 and 11 as originally filed. Original application claim 1 is repeated below in Table II together with a column including claims 10 and 11.

As noted above, the second step in determining whether the recapture rule is applicable is to ascertain whether the broader aspects of the reissue claims relate to the surrendered subject matter. With regard to the rejected claims at hand, appellant respectfully submits that the broader aspects of the reissue claim 16, namely the absence of the limitation of "said locking element (30) being guided over a dovetail guide (31) on the outer surface of the outer housing (3)" was not contained in claims 1, 10, or 11 and was required in claim 12 for patentability. Hence, the omission of this limitation in reissue claim 16 is germane to the prior art rejection. Also, this implies that the "surrendered" subject matter could only have been derived from the scope of canceled original patent claims 1, 10 and 11 set out above.

Appellant respectfully refers the Board to Table II below which compares the reissue claim 16 with canceled original application claims 1, 10, and 11. Using the analysis set out in Eggert, a determination must be made whether the broadenings of the claims during prosecution relate to surrendered subject matter. A review of the prosecution history as set out above reveals that the additional language of claim 12 (i.e., "said locking element (30) being guided over a dovetail guide (31) on the outer surface of the outer housing (3)") was necessary to secure an allowance over original base claim 1 and intervening claims 10 and 11. Thus, in conceding that claims 1, 10, and 11

were not patentable, the subject matter of those claims formed the surrendered subject matter for consideration herein. Hence, the omission of this limitation in reissue claim 16 is in an aspect germane to the prior art rejection.

Still further following the Eggert analysis, the next stage in the inquiry is to compare the rejected reissue claims to the surrendered subject matter to determine in what aspects the reissue claims are broader than the surrendered subject matter and in what aspects the reissue claims are narrower than the surrendered subject matter. Reissue claim 16 is in no way broader than the surrendered subject matter [original application claims 1, 10, and 11]. Each and every limitation of the surrendered subject matter finds a corresponding limitation in reissue claim 16.

Next, a determination must be made if the reissue claims are narrower than the surrendered subject matter. With reference again to Table II, reissue claim 16 has been narrowed relative to the surrendered subject matter in that it includes the limitation of "the clip connection securing the outer housing to the locking element and joining the inner frame, the outer housing, and the check valve element to the motor vehicle." Reissue claim 16 has the same scope as the surrendered subject matter in an aspect germane to the prior art rejection (i.e., "said locking element (30) being guided over a dovetail guide (31) on the outer surface of the outer housing (3)"). More particularly, neither the surrendered subject matter (original claims 1, 10, and 11) nor reissue claim 16 includes this limitation. Thus, the surrendered subject matter has not been expanded by the scope of reissue claim 16.

Therefore, it is respectfully submitted that in the case at hand based upon the above, reissue claim 16 falls into either category (2) or (3)(b) as described by Clement.

The majority opinion in Eggert suggests that the narrowing of the reissue claim does not have to be in the aspect of the invention, as long as the narrowing overcomes the rejection of the canceled claim. In that connection, applicant has enclosed herewith a copy of a Notice of Allowability in this reissue application whereat the Examiner has allowed claims 1-14 and 16 on their merits over the art of record. It is respectfully submitted that reissue claim

16 is patentable over the prior art and is narrower than the scope of the rejected claim (original claims 1, 10, and 11) and, accordingly, falls entirely within the outer circle in the Eggert Analysis.

Reissue claim 16 is narrower than the scope of the rejected claim (claim 11) and, accordingly, does not recite surrendered subject matter and is therefore allowable under the Eggert Analysis. More particularly, original application claim 11 recites a check valve assembly in association with the ventilation system for the passenger space of a motor vehicle, the assembly comprising an outer housing, an inner frame, a check valve element, and a resilient clip connection. In reissue claim 16, a check valve assembly is recited adaptable for use with a ventilation system of a passenger space of a motor vehicle, the assembly comprising an outer housing, an inner frame, a check valve element, and a resilient clip connection. In original claim 11, the outer housing is connected with the inner frame. In reissue claim 16, the outer housing has an open end and the inner frame is received in the open end, the clip connection securing the outer housing to the locking element and joining the inner frame, the outer housing, and the check valve element to the motor vehicle. In original patent claim 11, the check valve element is formed of a flexible sheet material clamped between the outer housing and the inner frame. In reissue claim 16, the check valve element is formed of a flexible sheet material clamped between the outer housing and the inner frame. In original claim 11, the assembled unit comprising the inner frame, the outer housing, and the check valve are joined to a support of the motor vehicle through a resilient clip connection carried on the outer housing. In reissue claim 16, a resilient clip connection is provided formed separate from the outer housing and carried on a locking element which is connected with the outer housing, the clip connection securing the outer housing to the locking element and joining the inner frame, the outer housing, and the check valve element to the motor vehicle. In original application claim 10, the resilient clip connection comprises a springy tongue formed separate from the outer housing. In reissue claim 16, the resilient clip connection is formed separate from the outer housing and is carried on a locking element. In original application claim 11, the springy

tongue of the clip connection is arranged on a locking element which can be connected with the outer housing. In reissue claim 16, the resilient clip connection is formed separate from the outer housing and is carried on a locking element which is connected with the outer housing.

As can be seen from the above, reissue claim 16 is narrower than the scope of the rejected claim (claims 1, 10, 11) and, therefore, falls entirely within the outer circle in the Eggert Analysis.

Accordingly, reissue claim 16 should be allowed and the rejection under the recapture rule withdrawn.

Therefore, for at least the above reasons, applicant respectfully submits that reissue claim 16 is allowable and does not violate the Recapture Doctrine according to the Eggert analysis.

IX. APPENDIX

Claims 1-13 stand allowed and are as set out in the Appeal Brief filed on July 10, 2000.

14. A check valve assembly adaptable for use with a ventilation system for a passenger space of a motor vehicle, the assembly comprising:
an outer housing having an open end and a surrounding wall;
an inner frame received in the open end;
a check valve element formed of flexible sheet material clamped between the outer housing and the inner frame; and,

first and second resilient clip connections joining the outer housing, the inner frame, and the check valve element to a support of the motor vehicle, the first clip connection comprising a first springy tongue spaced from the wall, and the second clip connection comprising a second springy tongue integral with the surrounding wall.

16. A check valve assembly adaptable for use with a ventilation system of a passenger space of a motor vehicle, the assembly comprising:

an outer housing having an open end;

an inner frame received in the open end;

a check valve element formed of flexible sheet material clamped between the outer housing and the inner frame; and,

a resilient clip connection formed separate from the outer housing and carried on a locking element which is connected with the outer housing the clip connection securing the outer housing to the locking element and joining the inner frame, the outer housing, and the check valve element to the motor vehicle.

⊙

X. TABLES

TABLE I

Original Application Claim 1	Patent Claim 1	Reissue Claim 14
1. In a <u>check valve assembly</u> in association with the ventilation system for the passenger space of a motor vehicle, said assembly comprising:	1. In a <u>check valve assembly</u> in association with the ventilation system for the passenger space of a motor vehicle, said assembly comprising:	14. A <u>check valve assembly</u> adaptable for use with a ventilation system for a passenger space of a motor vehicle, the assembly comprising:
an <u>outer housing</u> to which	an <u>outer housing</u> to which	an <u>outer housing</u> having an open end and a surrounding wall;
an <u>inner frame</u> is connected with	an <u>inner frame</u> is connected with	an <u>inner frame</u> received in the open end;
a <u>check valve element</u> formed of flexible sheet material clamped between the outer housing and the inner frame, the improvement wherein the inner frame (4) is received into an open end of the outer housing (3); and,	a <u>check valve element</u> formed of flexible sheet material clamped between the outer housing and the inner frame, the improvement wherein the inner frame (4) is received into an open end of the outer housing (3); and,	a <u>check valve element</u> formed of flexible sheet material clamped between the outer housing and the inner frame; and,
the assembled unit comprising the inner frame (4), the outer housing (3), and the check valve (3) is joined to a support (2) of the motor vehicle through a <u>resilient clip connection</u> (6) carried on the outer housing (3).	the assembled unit comprising the inner frame (4), the outer housing (3), and the check valve element (3) is joined to a support (2) of the motor vehicle through a <u>resilient clip connection</u> (6) carried on the outer housing (3); and,	first and second <u>resilient clip connections</u> joining the outer housing, the inner frame, and the check valve element to a support of the motor vehicle,
	wherein the inner frame (4) has a surrounding rim (7) carrying rib members (8) spaced transversely with stays (9) extending therefrom and a surrounding frame (10) joining the stays (9).	
		the first clip connection comprising a first springy tongue spaced from the surrounding wall, and the second clip connection comprising a second springy tongue integral with the surrounding wall.

TABLE II

Original Application Claim 1	Original Dependent Claims 10, 11	Patent Claim 11	Reissue Claim 16
1. In a <u>check valve assembly</u> in association with the ventilation system for the passenger space of a motor vehicle, said assembly comprising:		11. In a <u>check valve assembly</u> in association with the ventilation system for the passenger space of a motor vehicle, said assembly comprising:	16. A <u>check valve assembly</u> adaptable for use with a ventilation system of a passenger space of a motor vehicle, the assembly comprising:
an <u>outer housing</u> to which		an <u>outer housing</u> to which	an <u>outer housing</u> having an open end;
an <u>inner frame</u> is connected with		an <u>inner frame</u> is connected with	an <u>inner frame</u> received in the open end
a <u>check valve element</u> formed of flexible sheet material clamped between the outer housing and the inner frame, the improvement wherein the inner frame (4) is received into an open end of the outer housing (3) and		a <u>check valve element</u> formed of flexible sheet material clamped between the outer housing and the inner frame, the improvement wherein the inner frame (4) is received into an open end of the outer housing (3) and the assembled unit comprising the inner frame (4), the outer housing (3), and the check valve (3) is joined to a support (2) of the motor vehicle through	a <u>check valve element</u> formed of flexible sheet material clamped between the outer housing and the inner frame; and,
the assembled unit comprising the inner frame (4), the outer housing (3), and the check valve (3) is joined to a support (2) of the motor vehicle through a <u>resilient clip connection</u> (6) carried on the outer housing (3).		a <u>resilient clip connection</u> (6) carried on the outer housing (3) and, wherein the clip connection (6) comprises a springy tongue (22')	a <u>resilient clip connection</u>
	10. The assembly as defined in claim 1 wherein the clip connection (6) comprises a springy tongue (22') formed separate from the outer housing (3).	<u>formed separate from the outer housing (3)</u> , said springy tongue (22') being <u>arranged on a locking element</u> (30)	<u>formed separate from the outer housing and carried on a locking element</u>

Original Application Claim 1	Original Dependent Claims 10, 11	Patent Claim 11	Reissue Claim 16
	11. The assembly as defined in claim 10 wherein the springy tongue (22') is arranged on a locking element (30) which can be connected with the outer housing (3).	which can be <u>connected with the outer housing</u> (3), and	which is <u>connected with the outer housing</u>
		said locking element (30) being guided over a dovetail guide (31) on the outer surface of the outer housing (3).	
			the clip connection securing the outer housing to the locking element and joining the inner frame, the outer housing, and the check valve element to the motor vehicle.

CONCLUSION

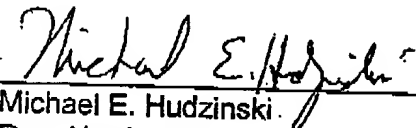
In view of the above comments and arguments presented, applicant respectfully submits that reissue claims 14 and 16 are allowable under the Recapture Doctrine and in view of the references of record.

Claims 1-13 stand allowed.

Allowance of all claims and early notice to that effect is respectfully requested.

Respectfully submitted,

FAY, SHARPE, FAGAN,
MINNICH & McKEE, LLP

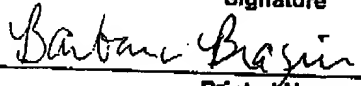

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Printed Name
Barbara Brazier

Notice of AllowabilityApplication No.
08/230,083

Applicant(s)

Willibald Kraus

Examiner

H. Joyce

Group Art Unit
3404

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance and Issue Fee Due or other appropriate communication will be mailed in due course.

☒ This communication is responsive to July 12, 1996

☒ The allowed claim(s) is/are 1-14 and 16

☐ The drawings filed on _____ are acceptable.

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

A SHORTENED STATUTORY PERIOD FOR RESPONSE to comply with the requirements noted below is set to EXPIRE **THREE MONTHS** FROM THE "DATE MAILED" of this Office action. Failure to timely comply will result in ABANDONMENT of this application. Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

☐ Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL APPLICATION, PTO-152, which discloses that the oath or declaration is deficient. A SUBSTITUTE OATH OR DECLARATION IS REQUIRED.

☒ Applicant MUST submit NEW FORMAL DRAWINGS

☐ because the originally filed drawings were declared by applicant to be informal.

☒ including changes required by the Notice of Draftsperson's Patent Drawing Review, PTO-948, attached hereto or to Paper No. 6.

☐ including changes required by the proposed drawing correction filed on _____, which has been approved by the examiner.

☐ including changes required by the attached Examiner's Amendment/Comment.

Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the reverse side of the drawings. The drawings should be filed as a separate paper with a transmittal letter addressed to the Official Draftsperson.

☐ Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Any response to this letter should include, in the upper right hand corner, the APPLICATION NUMBER (SERIES CODE/SERIAL NUMBER). If applicant has received a Notice of Allowance and Issue Fee Due, the ISSUE BATCH NUMBER and DATE of the NOTICE OF ALLOWANCE should also be included.

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

☐ Interview Summary, PTO-413

☐ Examiner's Amendment/Comment

☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material

☐ Examiner's Statement of Reasons for Allowance

H. JOYCE
PRIMARY EXAMINER
ART UNIT 3404

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE REISSUE APPLICATION OF : Willibald KRAUS
FOR : CHECK VALVE ASSEMBLY
SERIAL NO. : 08/230,083
FILED : April 20, 1994
EXAMINER : H. Joyce
ART UNIT : 3749
CONFIRMATION NO. : 5512
LAST OFFICE ACTION : November 8, 2004
ATTORNEY DOCKET NO. : TRWZ 2 00136-4

**RESUBMISSION OF EARLIER REQUESTED
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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Applicant respectfully reiterates the earlier filed Request for Oral Hearing with the Board of Patent Appeals and Interferences in the above-identified reissue application.

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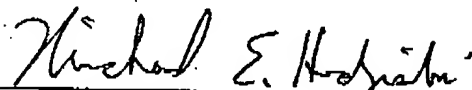
Signature

Printed Name
Barbara Brazier

Notification of a time and setting for the Oral Hearing is anxiously awaited.

Respectfully submitted,

FAY, SHARPE, FAGAN,
MINNICH & McKEE LLP



James W. McKee, Reg. No. 26,482
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		Art Unit 2604	Examiner H. Joyce
Applicant hereby requests an oral hearing before the Board of Patent Appeals and Interferences in the appeal of the above-identified application.			
The fee for this Request for Oral Hearing is (37 CFR 41.20(b)(3))		\$ 290.00	
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Reply Brief

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